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ARTHUR R. EGLINGTON
113 Cross Creek Dr. R.D. # 5.
Pottsville, PA 17901

[REDACTED] EXAMINER

HUI, SAN MING R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/989,019
Filing Date: November 21, 2001
Appellant(s): PUGLIESE, PETER T.

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GROUP 2900

Arthur R. Adlington
113 Cross Creek Dr., R.D.#5
Pottsville, PA 17901
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 4, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

Upon reconsideration, claim 8, which drawn to the method of treating cellulite, is allowed. Claims 1-7 and 9-11 are remain rejected.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention is not contained in the brief filed February 4, 2003.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-7 and 9-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|--|----------------|--|
| 5,436,230 | Soudant et al. | 7-1995 |
| 5,804,596 | Majeed et al. | 9-1998 |
| 5,776,906 | Sekiya | 7-1998 |
| 4,288,433 | Koulbanis | 9-1981 |
| JP 7-61927 | Lotte | 3-1995 (English translation is provided herein) |
| WO 98/01128 | De Simone | 1-1998 |
| Kuppusamy et al. Biochem Pharmacol., 1992;44(7):1307-1315 | | |
| Gennaro, Remington's Pharmaceutical Science, 18th ed., 1990, pages 1305-1307 | | |

(10) Grounds of Rejection

Claim 8 has been allowed. Examiner found appellant's argument persuasive.

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

Claim 8 directed to a method of treating cellulite is found allowable. Cited prior art, save Koulbanis and Soudant et al., are silent on treating cellulites. These anticellulites recitation are not regards to obviate the claims 1-7 and 9-11. Rebuttal arguments at Brief, pages 8-12 are persuasive to support the use set forth in claim 8. Examiner found the presented arguments convincing and, thus, allowed claim 8. Examiner notes that compositions of matter are useful for any purpose. Use not

envisioned by Appellant can be applied to provide motivation for obviating composition claims.

Examiner finds unconvincing Appellant's rebuttal arguments presented on page 3 – 12, especially page 6-7, averring a patentable distinction residing in the preambles, and the intended purpose, envisioned for the herein claimed compositions (i.e., so as to be applied onto skins with cellulites). These arguments are flawed as discussed below.

As Examiner notes above, the instant claims are drawn to a composition comprising carnitine, forskohlin, quercetin, fisetin, genistein, theophylline, and commonly used gel-forming agents such as methylcellulose and carrageenan. Moreover, examiner notes the claims fail to recite any specific use to patentably distinguish the envisioned composition from those individual compound prior art use (note that the claims are drawn to a composition suited for topical application to skin having cellulites, not the treatment of cellulites). One of ordinary skill in the art would see the instant claimed composition as reading on a mixture of the individual components, old and well-known for the same use, though this use was not envisioned by the inventor. In other words, the examiner may employ different reason for combining the herein recited components into a single composition, different than that use the appellant envisioned. Examiner directs attention to *In re Dillon* (See *In re Dillon* 16 USPQ 2d, 1897 at 1900 (CAFC 1990)) where the court sitting *in banc* ruled that the recitation of new utility for an old and well-known composition does not render that composition new. A mere mentioning of intended use, as on the specific skin area, fails to provide a distinguishing claim limitation (See *In re Dillon* supra at 1902). Moreover,

examiner notes those criticalities residing in a specific narrowed amount have not been demonstrated. Absent a showing of unexpected benefits residing in the claimed composition, one of ordinary skill in the art would have been motivated to incorporate the herein claimed components into a single composition based on the prior art use of these compounds individually for the same purpose.

As discussed in the previous office action mailed September 10, 2002, all the claimed compounds herein are known as useful as a fat degradation promoting compounds. It flows logically to combine those agents herein claimed into a fat-degradation promoting composition since they are known to be useful individually for promoting fat degradation (See *In re Kerkhoven* 205 USPQ 1069). Furthermore, the optimization of result effect parameters (e.g., amount of the actives) is obvious as being within the skill of the artisan. Furthermore, employing the herein recited commonly known gelling agents to thicken a dermal composition would have been well known to those skilled artisan.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, all the recited active agents, i.e., carnitine, forskohlin,

Art Unit: 1617

quercetin, fisetin, genistein, and theophylline, are taught in the cited prior art useful as fat degradation promoting agents or lipolytic agents. Absent evidence to the contrary, the skilled artisan would have seen combining those agents herein into a fat-degradation promoting composition as obvious, since they are known to be useful individually for promoting fat degradation (See *In re Kerkhoven* 205 USPQ 1069).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, motivation to combine the individual ingredients lies within the cited prior art's teachings that all the active agents herein employed are useful for fat degradation or lipolysis. The *Kerkhoven* court provided the motivation to combine the claimed agents into a single composition useful for the very same purpose; absent evidence to the contrary (see *In re Kerkhoven* 205 USPQ 1069).

In response to appellant's rebuttal arguments attacking the references individually; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner believes Appellant's rebuttal on "*In re [:] Dembicczak [et al.]* ((175 f.3d 994), 50 USPQ2d 1614 (CAFC 1999)) is misplaced.

Dembiczak deals with an orange plastic trash bag improved to resemble a jack-o'-lantern. The court found no motivation, save hindsight, linking the examiner cited prior art. To obviate, the examiner must provide "evidence of a suggestion, teaching or motivation to combine" flowing from "the prior art teaches themselves, the knowledge of one of ordinary skill in the art, or, in some cases from the nature of the problem to be solved." (See *In re Dembicczak, supra* 1617). In the instant case Examiner employs all three above suggestions to combine motivating the proffered obvious rejections. Each element employed in the instant claimed component is old and well known for the lypolytic properties. Thus, those compounds herein employed would have been seen as a homogenous group of compounds linked by a common therapeutic goal. Possessing a use for a common therapeutic goal, these compounds would have been seen as logical alternatives to be employed for obtaining their common old and well known lypolytic activity.

In the instant case we need not to employ these rationales. Examiner notes that compositions of matter are useful for any purpose, and are not patentably distinguished by intended use (*In re Dillon supra*). In addition, the skilled artisan would see concomitant employment of compounds, old and well known for the same use as *prima facie* obvious (See *In re Kerkhoven* 205 USPQ 1069).

For the above reasons, it is believed that the rejections should be sustained.

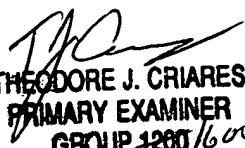
Application/Control Number: 09/989,019
Art Unit: 1617

Page 8

Respectfully submitted,

San-ming Hui
April 18, 2003

Conferees


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200/600


RUSSELL TRAVERS
PRIMARY EXAMINER

ARTHUR R. ADLINGTON
113 CROSS CREEK DR., R.D.#5
POTTSVILLE, PA 17901


SREENI PADMANABHAN
PRIMARY EXAMINER (SRE/AU 1617)